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In The

SUPREME COURT OF THE UNITED STATES

October Term, 1975

No. 75-885

DIAMOND INTERNATIONAL CORPORATION,
Petitioner,

v.

MARYLAND FRESH EGGS INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION

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COUNTERSTATEMENT OF THE QUESTIONS PRESENTED

(1) Whether the standard of review employed by the Court of Appeals in determining obviousness was proper, where the patent claims nothing more than the use of an old "button and hole" type latch on an old egg carton, for the simple purpose of holding the lid closed.

(2) Whether the Court of Appeals correctly evaluated the alleged invention against the prior art, and correctly determined the question of obviousness.

COUNTERSTATEMENT OF THE CASE

1. History of the Litigation

This is a conventional, straightforward suit for patent infringement. It involves a simple, everyday article — an egg carton. Petitioner, a very large manufacturer of molded pulp egg cartons, brought suit in the United States District Court for the District of Maryland against respondent, a small distributor of eggs. The respondent was charged with infringing Reifers Patent No. 2,990,094 ('094) by selling polystyrene egg cartons manufactured by Dolco Packaging Corp., which defended the suit.

The District Court held that the patent in suit was valid and was infringed by the polystyrene egg cartons sold by respondent. That decision appears at 374 F.Supp. 1223. On appeal, the United States Court of Appeals for the Fourth Circuit held that the patent was invalid for obviousness under 35 U.S.C. § 103 and for lack of novelty under 37 U.S.C. § 101 and 102(a). The decision was unanimous. The Court of Appeals found it unnecessary to pass on the question of infringement which had also been vigorously presented for review in that Court. The Court of Appeals decision appears at 523 F.2d 113.

Following the appellate decision, petitioner filed a petition for rehearing with a suggestion for rehearing in banc. It was denied; none of the appellate judges sought a poll of the entire Court.

The patent in suit will expire in slightly over two years. The only other pending action involving it is a related suit against Dolco and its two parent companies, filed after the District Court decision below.

2. The Patent in Suit

The Reifers patent in suit is directed to a cover latch on molded pulp egg cartons of the type that are used in the retail sale of a dozen eggs. The subject matter of the patent came into being when Reifers' boss (John Cox) instructed him to put a new latch on a *preexisting*, successful egg carton (Jt. App. 533*). That basic prior carton was known as the "Case Ace" and was the subject of Cox Patent No. 2,771,233 (Jt. App. 523; Pretrial Order, Res. App. 1a; the Cox '233 patent is reproduced at Pet. App. 155a). The Case Ace had been developed some eighteen months earlier, and had been a major advance, a "turning point", in egg carton design (Jt. App. 342, 523). The Case Ace had a frictional latch.

Reifers' sole contribution to that carton was substituting an *old* "button and hole" type of latch, or lock, for the frictional latch originally employed on the earlier Case Ace carton. *The patent in suit stands for nothing more than the prosaic addition of an old lock to an old carton.*

A more complete description of Reifers' latched carton is set forth in the decision below, 523 F.2d at page 115 (Pet. App. 4a). Figure 1 of the Reifers patent is reproduced below, with the carton components labelled on it:

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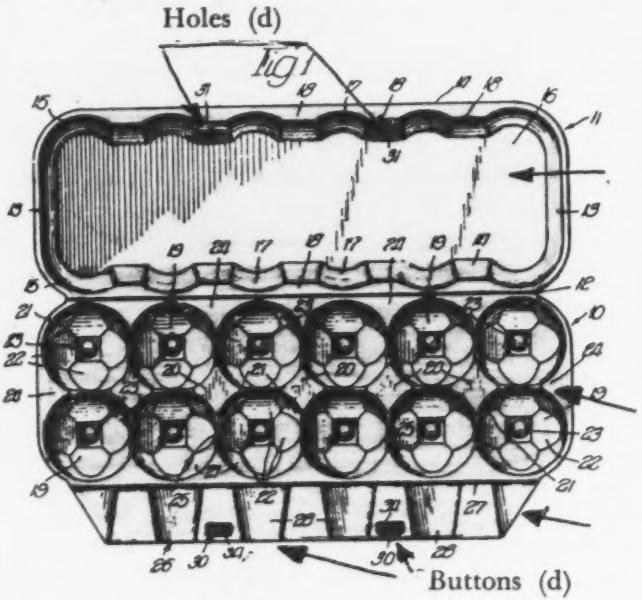
* The following references will be used throughout respondent's brief: "Jt. App." refers to the joint appendix filed in the United States Court of Appeals for the Fourth Circuit in connection with Appeal No. 74-2104. "Pet. App." refers to the appendix to the Petition for Certiorari. "Res. App." refers to the appendix to this brief.

PLATE I

June 27, 1961 R. F. REIFERS 2,990,094

MOLDED PULP EGG CARTON

Original Filed Dec. 16, 1955 2 Sheets—Sheet 1



As is shown above, the Reifers carton includes:

(a) A "cellular" tray compartmented to provide pockets or "cells," for eggs;

(b) A dished cover or lid hinged to one side of the tray to form a top closure for the tray;

(c) A flap hinged to the tray, the flap being bendable so as to fit within the cover when the carton is closed.

[*The above components — colored yellow in Plate I — constitute the preexisting Cox prior art egg carton* (*Res. App. 2a*).]

Reifers' modification of the Cox carton comprised solely this:

(d) A "button and hole" type latch, or lock, consisting of one or more "holes", or apertures, formed in the front wall of the cover, and one or more "buttons" or projections formed on the flap and positioned to enter the holes in the cover when the carton is closed. (The buttons and holes are colored red in Plate I.) The function of this latch is to hold the cover in a closed position.

3. The Case Ace Carton

It is flatly admitted by petitioner that the basic carton shown in the Reifers '094 patent – i.e., everything except the lock – was old and was not invented by Reifers (Res. App. 2a). It all appears in the earlier Case Ace carton, which had been developed in the latter part of 1949 or 1950 by John Cox (Jt. App. 342, 523). The Case Ace was in regular commercial production; millions of them had been sold prior to Reifers' development (Jt. App. 342, 127).

As shown in the Cox '233 patent itself, the Case Ace carton was latched *frictionally* by the engagement of its flap with the inside of the top cover (Pet. App. 160a, col. 5, lines 38-47). A second version of the Case Ace was produced with tabs which were tucked in to lock the cover closed (Jt. App. 1185). It was known as the "Tab-Lock" version.

In September 1951, Reifers' boss gave him the express assignment of putting a better latch on the Case Ace (Jt. App. 1414), which had gone into production only a few months before. In a short time, Reifers suggested the latch shown in the patent in suit. In arriving at this carton latch, *he merely substituted a button and hole lock for the frictional latch employed in the Case Ace.* In doing this, Reifers just cut two holes (or "apertures") in the cover and glued two paper "buttons" onto the flap. He also cut off two small tabs, which were no longer required (Res. App. 2a). *That was all Reifers did.*

4. No New Result; No Synergism; No New Function

Petitioner has strained its ingenuity to the utmost in attempting to breathe complexity and mystique into the Reifers latched egg carton. The simple fact of the matter is, however, that Reifers' carton differs from its Case Ace predecessor only in the lock. It is uncontroverted that the lock is the *only* difference (Jt. App. 1b; Jt. App. 392, 547).

No new, surprising or synergistic result was achieved by substituting the button and hole lock for the friction lock. As Diamond's own witness admitted, *all the elements of the prior Cox carton continued to function in exactly the same way they had functioned in the past* (Jt. App. 387-392). The tray held the eggs, the cover covered the eggs, the flap went up inside of the cover and latched with the cover (now positively instead of frictionally). The partitions in the bottom held the hinge lines of the flap and cover parallel, as before. A fast-running, automatic machine closed the carton, just as similar machines had closed and locked the old Case Ace Tab-Lock carton (Jt. App. 400, 402). True, the buttons and holes fastened the cover a little more securely. That, however, had been the function of button and hole latches for almost a century, as discussed below.

Petitioner has asserted (Pet. 18) — wrongly — that Reifers' was the first, successful molded, integral, and nestable egg carton which could be locked by fast-running, automatic equipment without disturbing the eggs and which could be easily opened, locked and relocked by hand. On the contrary, the Case Ace Tab-Lock carton, as it existed before Reifers' carton, had all of these attributes.

The Case Ace Tab-Lock carton was molded, integral and fully nestable. It was locked by fast-running machines without disturbing the eggs. It was manually opened and relocked by users. These cartons worked so well that

Diamond's own publication, "The Pulper", lauded the Hood plant which automatically filled and locked Case Ace Tab-Lock cartons using fast-running, automatic equipment as "one of the fastest, most efficient in the East" (Jt. App. 1398). While Reifers' latched carton may have been an improvement, it did not provide any *new or unexpected result.*

Neither the District Court nor the Court of Appeals was able to find any new function or synergistic result flowing from the two holes which Reifers cut and the two buttons Reifers glued on the Cox carton. In this, they were manifestly correct. Although the petitioner belatedly asserts "synergism" here, there is no factual finding in support of its position in either opinion below. The carton merely holds eggs and the latch merely latches; no alchemy is involved.

REASONS FOR DENYING THE PETITION

I. There Was No Error in the Standard of Review Applied by the Court of Appeals in Determining Obviousness, 35 U.S.C. § 103

The Court of Appeals held that Reifers' improvement was obvious and not patentable. In so doing, the Court of Appeals applied the constitutional standard of patentability which this Court has so firmly established and which it reiterated in *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57, 61 (1969):

> "Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful know-

> ledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of * * * useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored." [Court's emphasis]

The latch adopted by Reifers was precisely such "existent knowledge". If sustained, the inherent effect of the Reifers patent would be to remove it from the public domain.

The Court of Appeals in the present case expressly followed and, indeed, in their own words (Pet. App. 13a), "continue obedient to the precepts of *Graham* v. *John Deere,* 383 U.S. 1 (1966)." That Court initially determined the differences between the Reifers carton and the prior art Case Ace carton. It noted that those differences consisted solely of the substitution in the Cox Case Ace carton of a button and hole latch for a frictional latch:

> "* * * the focal point is the latch, for only the latch is now in issue." (Pet. App. 6a)

Such button and hole latches, the Court went on to note, were common expedients, used for decades to latch covers to various boxes and other containers:

> "Repeatedly does it [the latch] appear in the non-egg uses just considered . . ." (Pet. App. 12a)

The Court of Appeals concluded that it would be obvious to any person having ordinary skill in the art that such a button and hole latch could be added to the Cox carton (Pet. App. 12a), as Reifers did.

The Court of Appeals also expressly referred to and followed (Pet. App. 6a) *Calmar* v. *Cook Chemical Company,* 383 U.S. 1 (1966), a companion case of *Graham* v. *John Deere,* supra. *Calmar* involved facts strikingly parallel to this case. In *Calmar,* the patent related to an improved form

of cap for an insecticide can. Analyzing the problems confronting the patentee in that case, one Scoggin, this Court found that those problems "were not insecticide problems; they were mechanical closure problems" (383 U.S. at 35). Similarly, here the Court recognized that the problem confronting Reifers was a latching problem, not an egg carton problem (Pet. App. 6a). In *Calmar,* this Court held that patents showing seals in other types of liquid containers (whether insecticide or not) were pertinent as prior art (388 U.S. at 37). Similarly, here, the Court below held that patents relating to latches for containers (whether egg cartons or not) are pertinent prior art. While the petitioner urges that the Court below relied on "patents from different arts directed to devices which performed different functions (Pet. brief p. 17), a latch is, after all, a latch. Under *Calmar,* where the problem is latching, it is appropriate to look to other latches.

Finally, the Court below concluded that the use of a button and hole latch on the Cox egg carton was obvious as of the time Reifers made his invention (Pet. App. 12a). In so doing, the Court refused to be swayed by the argument of long-felt need where, as in *Calmar, one of the basic elements of the combination, i.e., the Cox carton, had come into being only a short time before* Reifers' alleged invention.

The Court's decision below is totally consistent with the expressions of this Court in other cases dealing with the use of common expedients or the combination of old elements to solve a problem. Thus, over 40 years ago, this Court, in *Altoona Publix Theatres* v. *American Tri-Ergon Corp.,* 294 U.S. 477, 486 (1935), held that it was obvious to use a conventional expedient from the same or an analogous field:

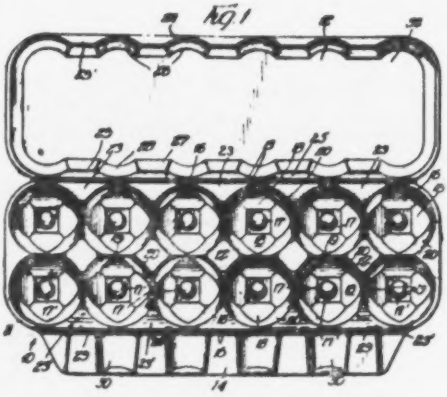
> "The inclusion of a flywheel in any form of mechanism to secure uniformity of its motion has so long been standard procedure in the field of mechanics and machine design that the use of it in the manner claimed by the present patent involved no more than the skill of calling."

This Court has consistently admonished that "courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements", *Great Atlantic & P. Tea Co.* v. *Supermarket Eq. Corp.*, 340 U.S. 147, 152 (1950). The evils so clearly recognized in *A&P* are precisely the evils caused by granting patents like the one here in suit. The expedient button and hole latch had been part of package designers' stock in trade for three-quarters of a century. The net effect of the Reifers patent was not to *add* to the sum of knowledge, but rather to *subtract that latch* from the tools otherwise available to package designers. This is surely not the intention of the constitutional provision regarding patents. The decision below insures that the prior field of available latches is not diminished by Reifers.

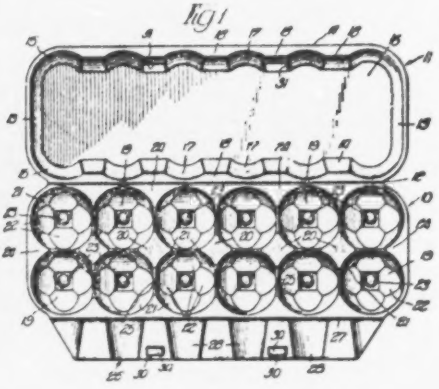
II. The Court of Appeals Correctly Evaluated the Alleged Invention against the Prior Art and Correctly Determined Obviousness

The Court of Appeals demonstrated a clear understanding of the patent in suit and its obvious evolution from the prior art. The Court's side-by-side comparison (Pet. App. 7a) of the Case Ace carton shown in the Cox '233 patent and the patented carton reproduced below shows, perhaps better than words, that the prior art Cox patent had every feature of the Reifers patent, except the button and holes:

Cox Patent No. 2,771,233



Reifers Patent No. 2,990,094



As the Court summarized the situation:

> " 'The *only structural differences* between the carton shown in the Reifers' patent in suit and the carton shown in the Cox '233 patent is the locking feature' . . . Instead of a latch to cover the tray and cover together, Cox relied upon the friction between the front of the cover and the flap . . ." (Court's emphasis, Pet. App. 6a)

The Court noted (Pet. App. 6a) that Reifers was employed by Cox to put a latch on Cox's carton and that Reifers, as a package designer, was aware that button and hole latches were a common expedient. In Reifers' own words:

> "The principle of hole and projection has been used for years in:
>
> 1. Leather goods
> 2. Hardware
> 3. Woven basket ware and
> 4. Cushion cartons." (DX 60, Jt. App. 1413)

Indeed, the principle had been specifically utilized to hold covers on boxes and thereby eliminate the very problems of the original Cox Case Ace carton, i.e., the need to improve the friction lock and eliminate the use of auxiliary fasteners.

The Court noted the long usage of this exact type of latch in the latching art. It made specific reference to several such prior art patents, including Tuttle Patent No. 117,349, granted in 1871. The object of the button and hole latch shown in the Tuttle patent is to hold a cover on a box and thereby "to dispense with the employment of strings, fastenings, or wrappers" (Pet. App. 179a). The Court also referred to Hooper British Patent No. 406,159 (Pet. App. 180a) and to Hunziker Patent No. 1,354,042 (Pet. App. 183a), each of which shows a container including a cover held in place by a button and hole latch on an upstanding flange which fits inside a cover much like Reifers. The drawings of those patents, which the Court of Appeals thought appropriate to reproduce in its opinion, speak more eloquently than words (Pet. App. 7a, 9a, 10a).

In addition to these patents, the Court's attention was drawn to Pollard Patent No. 320,814 (Jt. App. 1453),

granted in 1885, which shows a box including an upstanding flap and a cover held by a button and hole latch. The Pollard patent is significant because it first states that the flap can be used to hold the cover in place by friction (like the original Cox '233 carton). Its special pertinency is that it then goes on to state (Jt. App. 1454) that *a more preferable, positive lock between box and cover can be formed by adding a button and hole* — which is all that Reifers did, some 65 years later. In short, Pollard teaches that if a frictional latch is not secure enough (as it was not in Cox '233), then use a button and hole latch.

None of the foregoing latch patents was considered by the Patent Office in its examination of Reifers' application.

Finally, the Court referred to Koppelman Patent No. 2,093,280 which discloses a button and hole-type latch *in an egg carton.* That patent suggests the use of this type of latch in the egg carton field; and Cox '233 shows the identical carton body to which Reifers applied the latch.

Summing up, the Court held that the Reifers carton represented nothing more than an obvious adaptation of this well-known button and hole principle. That adaptation was certainly within the skill of the art and, indeed, the prior art patents gave explicit instructions for it.

Despite all of the artificial complexities which petitioner has tried to build into Reifers' development, the Court of Appeals saw it for what it really was — the obvious utilization of an old and well-known expedient.

CONCLUSION

There is no issue in this case which warrants consideration by this Court. It is purely a private controversy over a routine finding of obviousness. No unusual or controversial conclusions of law are involved. The legal issues that are involved have been correctly decided. There is no conflict of any sort between the Court of Appeals decision and any decision of this Court. Respondent perceives no merit in the "quota" review system urged by petitioner, and in any event there is simply no reason for reviewing *this* case. The petition should be denied.

Respectfully submitted,

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Certificate of Service

Service of the foregoing "Brief For Respondent In Opposition to Petition" was made on petitioner by mailing three copies thereof, first class postage prepaid on January ...., 1976 to Karl W. Flocks, Munsey Building, Washington, D.C. 20004.

APPENDIX

CIVIL ACTION No. 20809

[Dated March 23, 1971]

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND

DIAMOND INTERNATIONAL CORPORATION,
a corporation of Delaware,

Plaintiff,

v.

MARYLAND FRESH EGGS INC.,
a corporation of Maryland,

Defendant.

PRETRIAL ORDER

This matter came on for Pretrial Conference on February 5, 1971 attended by trial counsel for the parties. A proposed Pretrial Order was submitted by counsel for plaintiff who had previously conferred with counsel for defendant with respect to same and this proposed Pretrial Order together with memoranda submitted by both plaintiff and defendant served as an Agenda for discussion at the Pretrial Conference.

The following matters have been determined:

A. MATTERS AGREED UPON

* * *

32. Prior to February 21, 1952, plaintiff manufactured cartons as disclosed in Cox Patent No. 2,771,233 including

every structural element of the carton disclosed in the Reifers Patent No. 2,990,094 except for the locking feature which includes two buttons and two holes.

33. That in the commercial manufacture of the cartons of the type shown in the Cox '233 patent, the production of cartons included suction molding of wood fibers on the face of a porous mold conforming generally in shape to that shown in Figure 1 of the Cox '233 patent, with the cover and flap of the carton being in the open position shown in such figure.

34. That Reifers, the named inventor of the patent here in suit, in finally making the first integral and nestable sample of the structure shown in the patent here in suit, modified a physical commercial specimen of a tab lock carton having a cover and tray and flap as shown in the Cox '233 patent by cutting off the tab locks and by applying projections to an outer face of the flap of such carton and by cutting holes in the front wall of the cover in positions aligned longitudinally and vertically with the projections.

35. That the flap of the carton shown in the Cox '233 patent is hinged to rotate and tends to move to the horizontal position in which it was molded.

36. That upon closing the carton shown in the Cox '233 patent, the flap of the carton tends to rotate toward an open position except as restrained by its engagement with the inside front wall of the cover, and the cover of the carton tends to rotate toward an open position rather than stay closed. The restraining of the flap by the cover is not sufficient to lock the carton.

37. That the only structural differences between the carton shown in the Reifers patent in suit and the carton shown in the Cox '233 patent is the locking feature which includes provision of projections on the outside of the flap

member and apertures in the front wall of the cover positioned and dimensioned to receive such projections which extend therethrough from the inside to the outside.

38. Prior to 1952 many millions of folding paperboard self-locking egg cartons had been sold by DIAMOND's predecessor, The Self-Locking Carton Company, which cartons were closed and locked automatically by carton closing machinery.

* * *